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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/973,067
Filing Date: October 10, 2001
Appellant(s): SWART ET AL.

Swart et al.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 2, 2008 appealing from the Office action mailed April 1, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

NEW GROUND OF REJECTION

Further, claims 10-22 are rejected under 35 U.S.C. 112, second paragraph.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,600,573	HENDRICKS ET AL	2-1997
6,088,732	SMITH ET AL	6-2000

(9) Grounds of Rejection

The following grounds of rejection are applicable to the appealed claims:

Claims 1, 3-10, and 12-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks et al. (5,600,573, listed on the IDS submitted July 23, 2002) [Hendricks] in view of Smith et al. (6,088,732, of record) [Smith].

Regarding claims 1 and 10, Hendricks discloses an apparatus that decodes, formats, and codes content for storage and delivery (fig. 2, operations center 202, col. 21, lines 10-37), comprising:

means for providing two different formats for content storage (the apparatus supports both MPEG and ATM formats, col. 11 line 61 – col. 12 line 3);

means for receiving a coding and formatting request (system controller 312 sends a coding and formatting request for content to output equipment 320, col. 14 line 59 – col. 15 line 46 and col. 24, lines 43-64);

means for analyzing parameters contained in the coding and formatting request (output command and control module 500, col. 14, lines 20-38);

means for decoding, formatting in the two different format for content storage and coding target content (receiver 300 or equally, output equipment 320);

means for configuring the means for decoding formatting, and coding target content delivery (output command and control module 500);

means for routing coded target output content to one or more target addresses (output equipment 320, col. 10, lines 24-38);

means for analyzing auxiliary service requests in the coding and formatting request (the same means identified above which analyze the coding and formatting requests will analyze the auxiliary service requests found in the coding and formatting request, said auxiliary services relating to advertisement insertions determined by the CAP, col. 10, lines 39-67, col. 13, lines 42-65, and col. 17, lines 49-67);

means for configuring auxiliary services processing means to supply the requested auxiliary services (the same configuring means identified above); and

means for outputting the requested auxiliary services, whereby the outputted auxiliary services are combined with the coded target output content (the same routing means identified above).

Hendricks fails to disclose the coding and formatting request originates from a user.

In an analogous art, Smith teaches transmitting upstream, from users, content coding and formatting requests specifying desired content coding and formats, allowing users to specify precisely the manner in which they desire content to be delivered (col. 5 line 41 - col. 6 line 61, specifically the profiles which are sent upstream to an information source when the comparator is

located at the information source along with a request for content, said profiles specifying the content coding and formatting desired by a user).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method and apparatus of Hendricks for the coding and formatting request to originate from a user, as taught by Smith, for the benefit of granting individual users enhanced control over the coding and formatting of content delivered to their homes.

Regarding claims 3 and 12, Hendricks and Smith disclose the method and apparatus of claims 1 and 10, further comprising means for parsing auxiliary services and auxiliary service time code data (the apparatus determines both the advertisements to be inserted, the length of the advertisements, and when they should be inserted, Hendricks, col. 17, lines 49-67).

Regarding claims 4 and 13, Hendricks and Smith disclose the method and apparatus of claims 3 and 12, further comprising means for synchronizing the auxiliary service time code data and content time code data (the apparatus creates a schedule of programming that interleaves content and advertisements, Hendricks, col. 17, lines 49-67 and col. 19, lines 9-36).

Regarding claims 5 and 16, Hendricks and Smith disclose the method and apparatus of claims 1 and 10, wherein the auxiliary services comprises advertising (Hendricks, col. 17, lines 49-67).

Regarding claims 6 and 14, Hendricks and Smith disclose the method and apparatus of claims 1 and 10, whereby auxiliary services are combined with requested source content (Hendricks, col. 7, lines 5-25 and col. 9, lines 50-67), further comprising:

means for separating the auxiliary services from the requested source content (the apparatus parses and separates content into individual programs and advertisements for storage, Hendricks, col. 9, lines 65-67, "The storage device 308 stores some or all of the received programs and advertisements 212.", see also Hendricks, col. 11, lines 1-17 and col. 11 line 47 – col. 12 line 17);

means for processing the separated auxiliary service (advertisements are processed separately, Hendricks, col. 17, lines 49-67); and

means for combining selected separated auxiliary services with the coded target output content (Hendricks, col. 10, lines 52-55 and col. 17, lines 49-67).

Regarding claims 7 and 15, Hendricks and Smith disclose the method and apparatus of claims 1 and 10, wherein the requested auxiliary services are separate from the requested content (advertisements are individually selectable

and stored independently of other content in the storage device 308, Hendricks, col. 17, lines 49-67), further comprising:

means for formatting and coding the requested auxiliary services (Hendricks, col. 12 line 59 – col. 13 line 6); and
means for combining the requested formatted and coded auxiliary services and the coded target output content (Hendricks, col. 14, lines 15-38).

Regarding claims 8 and 17, Hendricks and Smith disclose the method and apparatus of claims 1 and 10, wherein upon receiving a formatting and coding request, formatting and coding means are identified (output means comprises a large number of duplicated components, Hendricks, col. 15, lines 31-46, wherein output equipment control means must send configuration information to the output equipment for accomplishing multiple tasks concurrently, col. 13, lines 18-33), but fails to disclose said identification is performed by a polling means.

It is notoriously well known in the art to poll electronic device to receive status information.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method and apparatus disclosed by Hendricks and Smith to identify formatting and coding means via polling means.

Regarding claims 9, 18, and, 19, Hendricks and Smith disclose the method and apparatus of claims 1 and 10, further comprising means for reading

target content routing address information and means for routing target content based on the address information (in addition to sending certain programming packages to certain cable headends, Hendricks, col. 10, lines 24-38 and col. 19, lines 9-35, the apparatus also routes specifically requested video on demand programs to subscriber sites, col. 19, lines 36-54).

Regarding claim 20, Hendricks and Smith disclose the apparatus of claim 10, wherein the parameter contained in the coding and formatting request comprises format description (see Hendricks, col. 11, lines 46-60, col. 12, lines 59-65, col. 13, lines 34-41, or col. 14, lines 20-38).

Regarding claim 21, Hendricks and Smith disclose the apparatus of claim 10, but fails to disclose applying forward error correction coding to target output content.

However, Hendricks does disclose a quality control module which performs quality control functions on output content (col. 14, lines 39-58). Forward error correction is notoriously well known in the art to maintain the quality of outgoing digital data.

It would have been obvious at the time to a person of ordinary skill in the art to modify the apparatus disclosed by Hendricks to applying forward error correction coding to target output content, for the benefit of maintaining the quality of outgoing digital content.

Regarding claim 22, Hendricks and Smith disclose the apparatus of claim 10, wherein the target addresses include an aggregator local storage (Hendricks, col. 12, lines 4-17) or a user terminal (for filling a video on demand request, Hendricks, col. 19, lines 36-54).

NEW GROUND OF REJECTION

Claims 10-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite the following means plus function limitation:

“means for analyzing parameters contained in the coding and formatting request from said user” (claim 10, lines 6-7)

In the instant application, the following portions of the specification and drawings may appear to describe the corresponding structure for performing the claimed function:

If the programming download request is to be fulfilled by the local aggregator 201, the local content request processor 451 of the content delivery server 450 (see Figure 6) analyzes the programming content's metadata and determines if the content is in the appropriate format and coding scheme for delivery to the user. (253, 274; p. 14, l1.5-8.)

The claims additionally recite the following means plus function limitations:

“means for decoding, formatting in at least one of two different formats for content delivery and coding target content” (claim 10, lines 8-9)

“means for configuring the means for decoding, formatting and coding target content, whereby coded target output content is produced in accordance with the coding and formatting request received from the user” (claims 10, lines 10-12)

In the instant application, the following portions of the specification and drawings may appear to describe the corresponding structure for performing the claimed functions:

The decoder and content formatter 252 decodes the incoming data and may extract digital and/or analog data representing the content and its metadata. The decoder and content formatter 252 then reformats the content into the required formats and coding schemes for delivery to the user. (253, 274; p. 14, l1.1-4.)

However, the specification and drawings do not disclose sufficient corresponding structure, material or acts for performing the claimed function. The specification discloses that the content request processor 451 and the content formatter 253 perform the claimed functions. However, the specification does not set forth the code, software instructions or algorithms executed in order to realize the claimed function. The specification merely states that these components perform analyzing parameters and

decoding, or configuring. For a computer-implemented means-plus-function claim limitation that invokes 35 U.S.C. 112, sixth paragraph, the corresponding structure must include the algorithm or code, as well as the general purpose computer or microprocessor.

As such, Appellants have failed to adequately describe sufficient structure for performing the functions claimed.

Each of claims 11-22 depend upon claim 10, thus includes the limitations described above, and are correspondingly rejected based on the same reasons as provided for claim 10.

(10) Response to Argument

Claims 1, 3-10 and 12-22

First, appellant argues that the combination of Hendricks and Smith does not teach the claimed limitation of "receiving a coding and formatting request in one of at least two different formats from a user and decoding, formatting, and coding target content using the configured formatting codec, whereby coded target output content is produced in accordance with the coding and formatting request received from the user." (appeal brief, pages 11-13). Appellant supports this argument by emphasizing that the information received from a user in Smith's disclosure is not used to perform any coding and formatting, but is instead used to determine whether a service can be provided at all (appeal brief,

page 13), and thus does not constitute a "coding and formatting request" as claimed.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, the coding and formatting request is explicitly taught by Hendricks, the primary reference, who teaches providing instructions on output formatting from the CAP interaction module (see Hendricks, col. 13, lines 31-54). The one and only claimed feature upon which Hendricks is silent is that said instructions originate from a user. Thus, Smith is provided as evidence to show that such information is known in the art to originate from users, explicitly informing content providers which kind of coding and formatting is supported by a user's home equipment. When Hendricks, a system which is disclosed as being capable of dynamically coding and formatting content as needed in response to user requests (see Hendricks, col. 13, lines 34-41), is modified in view of Smith, who teaches sending coding and formatting requirements upstream to inform a content provider what types of formats the user's home equipment is capable of receiving and rendering, the resultant combination teaches the claimed invention.

Second, appellant argues that Hendricks does not teach auxiliary service requests are provided in a coding and formatting request from a user, citing the selection of which advertisements to include (which constitute the auxiliary services) is performed by the CAP and not based on information received from a user (appeal brief, page 14).

In response, the claimed limitations call for “analyzing auxiliary services processing requests in the coding and formatting request” and “configuring one or more auxiliary services processes to generate requested auxiliary services”. These limitations do not specify the coding and formatting request to being inclusive of an actual selection of specifically which advertisements should be packaged with a requested program. The claimed limitations state the coding and formatting request includes instructions on how to process said auxiliary services. The outstanding rejection treats the actual processing of auxiliary services to be an analogous process to the processing of the main video content, as both the requested video and the advertisements packaged with it must be in the same format for display on a user’s home equipment.

Further, the support for said limitations is found on page 21 of appellant’s originally filed specification, which states that the auxiliary services include “closed captioning services, descriptive video services, advertising, interactive services, and data services.” The processing request received from the user, as supported by the specification, goes no farther than to state in some unspecified manner which services are desired, and nothing more. Regarding the

outstanding rejection, the auxiliary service requested is simply targeted advertisements, a feature that is included with a request for video on demand content (since video on demand content is part of the 'program lineup' of Hendricks, who teaches associating advertisements with programs in the program lineup, see Hendricks, col. 10, lines 39-55). Which advertisements are subsequently chosen for inclusion is as the discretion of the headend, and they are then coded and formatted according to the instructions received from the user.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR

41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Dominic D Saltarelli/

Examiner, Art Unit 2421

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Timothy P Callahan/

Director, Technology Center 2400

Conferees:

/John W. Miller/

Supervisory Patent Examiner, Art Unit 2421

/Scott Beliveau/

Supervisory Patent Examiner, Art Unit 2427